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Paper No. 10
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re US Airways, Inc.

Serial No. 75/536,451

Bruce J. Goldner and Ronald J. Turiello, Jr. of Skadden,
Arps, Slate, Meagher & Flom for US Airways, Inc.

Gretta Yao, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Hohein, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

US Airways, Inc. has filed a trademark application to register the mark PREFERRED for "transportation services, namely, airline passenger services in the nature of a frequent flier program having an elite tier offering a bonus program for frequent air travelers, namely, priority boarding, check-in, seating and reservation services; ticket upgrades; augmented frequent flier mileage."¹

¹ Serial No. 75/536,451, in International Class 39, filed August 14, 1998, based on use of the mark in commerce, alleging first use and use in commerce as of February 28, 1997.

The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that the term PREFERRED "conveys a sense of quality or excellence in the service customers receive when they achieve this level in applicant's frequent flier program"; that PREFERRED "is a frequently used term in the airline industry to describe a higher level and more desirable quality of service within their frequent flier programs"; and that PREFERRED is laudatory in this context and, thus, merely descriptive in connection with the identified services. In support of this position, the Examining Attorney submitted excerpts of articles from the LEXIS/NEXIS database wherein the term "preferred" is used by several different airlines to identify a certain category of frequent fliers and, generally, in reference to airline frequent flier programs. The following are several examples:

A spokesman for United later explained that the X's represented seats set aside for full-fare or preferred frequent fliers, and so, did not necessarily mean that those seats were sold. *The New York Times*, February 7, 1999.

Frequent fliers on Delta, both she and John have earned preferred status. *Pittsburgh Post-Gazette*, January 24, 1999.

In Northwest's case, [a free ticket is] a matter of flying 25,000 miles in one calendar year - not an easy thing to do, if you don't fly for business. Other programs have similar achievement levels. Good things occur as an elite flyer, such as upgrade coupons coming your way and mileage bonuses. But only the very, very frequent fliers get to appreciate all those preferred-status perks. *Capital Times (Madison, WI)*, September 15, 1996.

Forty percent of those surveyed said they are enrolled in five or six frequent-flier programs; half of all the respondents are preferred members in only one program. *The Orange County Register*, December 5, 1994.

The Examining Attorney also submitted copies of eight third-party registrations of marks including the term PREFERRED, with a disclaimer thereof, for various services. Among these registrations is a registration (No. 2,282,991) owned by this applicant of the mark DIVIDEND MILES PREFERRED PLUS, with a disclaimer of PREFERRED PLUS, for the same services as in this case.

Applicant contends that its mark is suggestive of its services. Applicant describes its services as follows:

Since at least February 28, 1997, applicant has used its PREFERRED mark to refer to the elite level of its frequent flier program. Once a member achieves this elite level, that member may enjoy priority boarding, check-in, seating and reservations services, as well as ticket upgrades and augmented frequent flier mileage. (Brief, p. 2.)

Applicant's mark merely suggests a specific class of service in which travelers may receive certain

unspecified, preferential treatment, and, as such, the mark is suggestive, not merely laudatory or descriptive. (Brief, p. 7.)

In support of its position, applicant states that it owns several registrations for marks incorporating the term PREFERRED with no disclaimer thereof. Applicant also submitted, during prosecution of the application, a list of 14 third-party registrations, with copies thereof from the Trademark Scan database, of marks containing the term PREFERRED for various services. Neither of these methods is an acceptable means of submitting evidence, whether of applicant's own prior registrations or of third-party registrations. But because the Examining Attorney did not object to this evidence, we have considered it to be of record. However, this evidence is of limited value because we cannot conclusively determine whether the registrations contain disclaimers of the term PREFERRED or whether the marks are registered under Section 2(f) of the Trademark Act, on the Supplemental Register or with disclaimers.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is

not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

In this case, we find that applicant's own description of its services and the use of the term "preferred" in the LEXIS/NEXIS excerpts clearly support the conclusion that applicant's asserted mark, PREFERRED, is laudatory in connection with an elite frequent flier status and, thus, the term is merely descriptive in connection with applicant's identified services.

The evidence regarding the term PREFERRED in third-party registrations is conflicting and inconclusive. It appears that even applicant's own registrations are inconsistent with respect to disclaimers of the term PREFERRED. Such inconsistency in third-party registrations

is immaterial, as we are bound to decide this case based upon the facts before us in this record.

In conclusion, it is our view that, when applied to applicant's services, the term PREFERRED immediately describes, without need of conjecture or speculation, a significant feature or function of applicant's services, as discussed above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of, and prospective customers for, applicant's services to readily perceive the merely descriptive significance of the term PREFERRED as it pertains to these services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.